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1732

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,318

Applicant(s)

SWAAB, MARY

Examiner

Stefan Staicovici

Art Unit

1732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 19-37, 39-42 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 19-37, 39-42 and 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 22, 2004 has been entered.

Response to Amendment

2. Applicant's amendment filed March 22, 2004 has been entered. No claims have been amended. Claims 14-18, 38 and 43 have been canceled. New claims 46-49 have been added. Claims 1-13, 19-37, 39-42 and 44-49 are pending in the instant application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7-13, 19-37, 39-42, 44-45 and 47-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 7, 19 and 26, the newly added limitation of pigments in “free of pre-measured individual units” does not appear to have support in the original disclosure. Although the original disclosure appears to have support for pigments in a powder form (see page 8, lines 7-8 and Figure 1), the original does not have support for pigments in bulk form “free of pre-measured individual units,” because said pigments may be counted one by one in order to fill a certain volume, such as a measuring spoon. Claims 8-13, 20-25 and 27-35, 37, 39-40, 42, 44-45 and 47-49 are rejected as dependent claims.

In claims 36-40, the newly added limitation of “without counting pellets” does not appear to have support in the original disclosure. The original disclosure never mentions “pellets” and as such, a limitation of “without pellets” does not have support in the original disclosure.

In claims 41-42 and 44-45, the newly added limitation of “at least one pigment in powder form” does not appear to have support in the original disclosure. The original disclosure appears to have support only for pigments in a powder form (see page 8, lines 7-8 and Figure 1), and as such, does not appear to have support for any other form in order to have a limitation of “at least one pigment in powder form.”

In claims 46-49, the newly added limitation of “wherein at least one of the pigments is in liquid form during said measuring step” does not appear to have support in the original disclosure. The original disclosure appears to have support only for pigments in a powder form (see page 8, lines 7-8 and Figure 1), and as such, does not appear to have support for any other form in order to have a limitation of “at least one of the pigments is in liquid form.” Further, it is

noted that the use of the term “pour” is not limited to liquids because a powder can also be poured.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7-13, 19, 23-29, 30-33, 37, 39-40, 42 and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)).

Regarding claims 7 and 26, Jean Putz *et al.* (Exhibit A) teach the claimed process of *custom* blending and fabricating lipstick (personal specifications of a person) (emphasis added) according to the wishes of an end-user including, providing a molding kit having a mold, a plurality of colored ground pigments (bulk form free of pre-measured individual units) plurality of bases, mixing a selected quantity of ground (powder) pigments (see page 75), softening a lipstick wax base (see page 59), mixing said pigments with said base to form a base-pigment mixture, correcting the color shade by adding more pigments (see page 75), heating said mixture such as to pour said mixture into a mold, cooling said mixture in the mold to form said lipstick and removing said lipstick for attachment to a lipstick case (see Figures on page 93). It is noted

that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of custom-making a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

In regard to claim 8, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach solid pigments and a wax base that has a melting temperature of 86°C (see page 59). It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.* (Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said kit of Jean Putz *et al.* (Exhibit A).

Specifically regarding claim 9, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade (see page 75).

Regarding claim 10, teach a selected quantity of ground (powder) pigments (see page 75). Since, Jean Putz *et al.* (Exhibit A) specifically teach mixing of said ground (powder)

pigments with a base, it is submitted that mixing occurs on a blending sheet since a powder is spread during mixing.

In regard to claim 11, Jean Putz *et al.* (Exhibit A) teach the use of a metered dose system because Jean Putz *et al.* (Exhibit A) teach specific “recipes” that one must follow including specific quantities of pigment and/or base needed that are measured using a measuring spoon (see pages 75-76).

Regarding claims 12-13 and 27-28, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the mold and affixing a casing prior to using said lipstick (see Figures on page 93). It is noted that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of *custom-making* (emphasis added) a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

In regard to claim 19, 29, 30 and 32-33 Jean Putz *et al.* (Exhibit A) teach heating of a custom made colored mixture such as to pour said mixture into a mold, cooling said mixture in

the mold to form said lipstick and removing said lipstick for attachment to a lipstick case (see Figures on page 93). Further, Jean Putz *et al.* (Exhibit A) specifically teach correcting the color shade generally by adding more pigments (see page 75). Hence, it is submitted that correcting a color shade by “*adding more pigments*”(emphasis added), such that it achieves a *desired* color shade (emphasis added) in the context of the teachings of Jean Putz *et al.* (Exhibit A), requires selecting, measuring and mixing more pigments into the liquefied mixture. It is further noted that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of *custom-making* (emphasis added) a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

Regarding claim 23, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade (see page 75). It is submitted that measuring of an amount of pigments has occurred prior to mixing said pigment/base mixture.

In regard to claim 24, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the clam-shell, transparent mold and affixing a casing prior to using said lipstick (see

Figures on page 93). It is noted that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of *custom-making* (emphasis added) a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

Specifically regarding claim 25, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.* (Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said mixing rod of Jean Putz *et al.* (Exhibit A) and that mixing occurs after said heating in order to be able to mix said base/pigment mixture into a uniform and homogeneous mixture.

Specifically regarding claim 31, Jean Putz *et al.* (Exhibit A) teach a plurality of bases that may be used (see pages 56-61).

Specifically regarding claims 37, 40, 42 and 45, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

In regard to claims 39 and 44, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611).

Jean Putz *et al.* (Exhibit A) teach the basic claimed process of custom blending and fabricating lipstick according to the wishes of an end-user including, mixing a selected quantity of ground (powder) pigments (see page 75), softening a lipstick wax base (see page 59), mixing said pigments with said base to form a base-pigment mixture, correcting the color shade by adding more pigments (see page 75), heating said mixture such as to pour said mixture into a mold, cooling said mixture in the mold to form said lipstick and removing said lipstick for

attachment to a lipstick case (see Figures on page 93). It is noted that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of *custom-making* (emphasis added) a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

Regarding claim 1, Jean Putz *et al.* (Exhibit A) do not teach applying the mixture to the customer for evaluation. Beal, Jr. ('611) teaches an applicator to test lipstick coloring at a retail establishment (see col. 2, line 66 through col. 3, line 4). Further, it should be noted that Beal, Jr. ('611) *specifically teaches the desirability* (emphasis added) of testing a lipstick color on a person's lips prior to purchasing said lipstick (see col. 1, lines 17-21). Furthermore, Jean Putz *et al.* (Exhibit A) *teach correcting the color shade* (emphasis added) by adding more pigments (see page 75). Therefore, it would have been obvious for one of ordinary skill in the art to have applied the mixture to the customer for evaluation as taught by Beal, Jr. ('611) in the process of Jean Putz *et al.* (Exhibit A) because, Beal, Jr. ('611) specifically teaches the desirability of testing a lipstick color on a person's lips prior to purchasing said lipstick, Jean Putz *et al.*

(Exhibit A) teach correcting the color shade by adding more pigments and also because, both references have applicability in the lipstick art.

In regard to claims 2 and 3, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach solid pigments and a wax base that has a melting temperature of 86°C (see page 59). It is submitted that heating of the mixture occurs in order to obtain a pourable liquid as shown in the Figures on page 93 of Jean Putz *et al.* (Exhibit A). Furthermore, because Jean Putz *et al.* (Exhibit A) teach a stirring rod (see Figure on page 63) it is submitted that the liquefied base/pigment mixture is mixed using said mixing rod of Jean Putz *et al.* (Exhibit A).

Specifically regarding claims 4 and 6, Jean Putz *et al.* (Exhibit A) teach removing the molded lipstick from the mold and affixing a casing prior to using said lipstick (see Figures on page 93). It is noted that Jean Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a “custom made” product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art. Furthermore, it should be emphasized that the teachings of Jean Putz *et al.* (Exhibit A) are directly drawn to a method of *custom-making* (emphasis added) a lipstick according to the wishes of the end user, and as such if those same wishes are expressed at the home of the end-user or at a retail establishment is a mere functional

limitation because the process is still a method of custom-making a lipstick according to the wishes of the end user.

Regarding claim 5, Jean Putz *et al.* (Exhibit A) teach a selected quantity of ground (powder) pigments (see page 75). Since, Jean Putz *et al.* (Exhibit A) specifically teach mixing of said ground (powder) pigments with a base, it is submitted that mixing occurs on a blending sheet since a powder is spread during mixing.

In regard to claims 36 and 41, Jean Putz *et al.* (Exhibit A) teach measuring (see page 73 describing a measuring spoon) and mixing a selected quantity of ground (powder) pigments (see page 75 describing grinding powder pigments in a mortar).

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Collins *et al.* (US Patent No. 5,780,018).

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) teach the basic claimed process as described above.

Regarding claim 22, although Jean Putz *et al.* (Exhibit A) teach adding Vitamin-E (anti-oxidant) (page 74), Jean Putz *et al.* (Exhibit A) in view Beal, Jr. ('611) do not teach adding moisturizers and a perfume to the pigment/base mixture. Collins *et al.* ('018) teach a process of manufacturing customized (personal specifications of a person) lipstick (lip coloring) including, selecting a particular color shade by a customer, providing a molding kit having a mold, a plurality of pigments provided as color pellets (pigments) or a colored semi-solid paste

(shapeless amorphous form) and a plurality of doses of oil blend (bases), measuring an amount of color pellets/semi-solid paste, mixing said color pellets/semi-solid paste with said oil blend, heating said mixture in a microwave oven (see col. 6, lines 27-35), pouring said mixture in a mold and cooling said mixture in said mold to form said customized lipstick. Further, Collins *et al.* ('018) teach adding moisturizers, an anti-oxidant and a perfume to the oil blend (base) and to the color pellet (see col. 3, lines 7-28). Therefore, it would have been obvious for one of ordinary skill in the art to have added moisturizers and a perfume as taught by Collins *et al.* ('018) to the pigment/base mixture in the process of Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) because, Collins *et al.* ('018) teach that such ingredients are added to lipstick materials, hence such ingredients improve the quality of the resulting lipstick by providing moisturizing protection for the end-user's lips or a pleasing aroma.

10. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12) in view of Brown (US Patent No. 5,903,465).

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. ('611) teach the basic claimed process as described above.

Regarding claims 47-49, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade. Furthermore, Jean Putz *et al.* (Exhibit A) specifically teach correcting the color shade generally by adding more pigments (see page 75). However, Jean Putz *et al.* (Exhibit A) do not teach using a liquid pigment. Brown

(‘465) teaches a process and apparatus for custom making a cosmetic product including using liquid pigments (see Abstract). Therefore, it would have been obvious for one of ordinary skill in the art to have used liquid pigment as taught by Brown (‘465) in the process of Jean Putz *et al.* (Exhibit A) in order to adjust the customized color shade because, liquid pigments are much easier to mix with a molten base/pigment mixture as required by the process of Jean Putz *et al.* (Exhibit A) and also because a liquid pigment is merely an equivalent alternative to a solid pigment because during the melting process a solid pigment becomes liquid.

11. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jean Putz *et al.* (1993) (Exhibit A in the Supplemental IDS filed September 2, 2003 (Paper No. 12)) in view of Beal, Jr. (US Patent No. 4,611,611) and in further view of Brown (US Patent No. 5,903,465).

Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. (‘611) teaches the basic claimed process as described above.

Regarding claim 46, Jean Putz *et al.* (Exhibit A) teach pouring a liquefied base/pigment mixture into a mold. Further, Jean Putz *et al.* (Exhibit A) teach using a plurality of different pigments in order to obtain a customized color shade. Furthermore, Jean Putz *et al.* (Exhibit A) specifically teach correcting the color shade generally by adding more pigments (see page 75). However, Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. (‘611) does not teach using a liquid pigment. Brown (‘465) teaches a process and apparatus for custom making a cosmetic product including using liquid pigments (see Abstract). Therefore, it would have been obvious for one of ordinary skill in the art to have used liquid pigment as taught by Brown (‘465) in the process of Jean Putz *et al.* (Exhibit A) in view of Beal, Jr. (‘611) in order to adjust the customized color

shade because, liquid pigments are much easier to mix with a molten base/pigment mixture as required by the process of Jean Putz *et al.* (Exhibit A) and also because a liquid pigment is merely an equivalent alternative to a solid pigment because during the melting process a solid pigment becomes liquid.

Allowable Subject Matter

12. Claims 20-21 and 34-35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's remarks filed March 22, 2004 have been considered.

Applicant argues that the limitations of "free from pre-measure individual units" (claims 7, 19 and 26), "without counting pellets" (claims 36-40), "at least one pigment in powder form" (41-42 and 44-45), "wherein at least one of the pigments is in liquid form during said measuring step" (claims 46-49) have support in the original disclosure because such limitation are "inherent" and as such are "disclosed and contained within the patent application 'even though the specification says nothing explicit concerning it' pursuant to MPEP §2163.07(a)" (see page 10 of the amendment filed March 22, 2004). In response, it is noted that MPEP §2163.07(a) specifically states that to:

“... establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

As such, in the instant application, as shown above, the limitations do not pass the “necessarily present” test as defined by *In re Robertson*. Specifically:

(a) the limitation of “free from pre-measure individual units”- As shown above, although the original disclosure appears to have support for pigments in a powder form (see page 8, lines 7-8 and Figure 1), the original does not have support for pigments in bulk form “free of pre-measured individual units,” because said pigments may be counted one by one in order to fill a certain volume, such as a measuring spoon. Hence, the limitation of “free from pre-measure individual units” is not “necessarily present” as required by *In re Robertson*.

(b) the limitation of “without counting pellets” - As shown above, the original disclosure never mentions “pellets” and as such, a limitation of “without pellets” does not have support in the original disclosure. Hence, the limitation of “without counting pellets” is not “necessarily present” as required by *In re Robertson*.

(c) the limitations of “at least one pigment in powder form” and “wherein at least one of the pigments is in liquid form during said measuring step” - The original disclosure appears to have support only for pigments in a powder form (see page 8, lines 7-8 and Figure 1), because it describes “melting” and using a “ graduated blending sheet. ” Further, it is noted that the term “pour” is not limited to liquids because a powder can also be poured. Hence, the limitations of

“at least one pigment in powder form” and “wherein at least one of the pigments is in liquid form during said measuring step” is not “necessarily present” as required by *In re Robertson*.

Furthermore, it is noted that under MPEP §2112.02 “[U]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.” *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). It is submitted that Jean Putz *et al.* (Exhibit A) teach the claimed process of *custom* blending and fabricating lipstick (personal specifications of a person) (emphasis added) according to the wishes of an end-user including, providing a molding kit having a mold, a plurality of colored ground pigments (bulk form free of pre-measured individual units) plurality of bases, a stirring rod and a heating source. As such, it is submitted that Jean Putz *et al.* (Exhibit A) teach mixing a selected quantity of ground (powder) pigments (see page 75), softening a lipstick wax base (see page 59), mixing said pigments with said base to form a base-pigment mixture, correcting the color shade by adding more pigments (see page 75), heating said mixture such as to pour said mixture into a mold, cooling said mixture in the mold to form said lipstick and removing said lipstick for attachment to a lipstick case (see Figures on page 93).

Applicant argues that Jean Putz *et al.* (Exhibit A) does not teach the limitation of “receiving a customer demand from the person for a custom blended lipstick at the retail establishment” (see page 11 of the amendment filed March 22, 2004). As shown above, Jean

Putz *et al.* (Exhibit A) specifically teach a process for custom blending and fabricating lipstick. As such, it is submitted that a "custom made" product is made according to the wishes and desires of the end consumer. Whether these wishes are made at a retail establishment or at the home of an end-user of said lipstick appears to be a functional limitation because it is drawn to a process of using the kit either at a retail establishment or at home. In a claim drawn to a method of making, the intended use must result in a manipulative difference as compared to the prior art, whereas whether the process is carried out in a retail establishment or at home does not introduce such an active and positive manipulative difference in the process steps because the claimed process is still a method of custom-making a lipstick according to the wishes of the end user.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1732

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD

A handwritten signature in black ink, appearing to read 'Stefan Staicovici', written over the printed name.

Primary Examiner

6/12/04

AU 1732

June 12, 2004